

USSN: 10/698,344
Group Art Unit: 3763
Docket No.: 151-P-11699US01

REMARKS

Claims 1 – 6 and 8 – 16 are pending in this application.

Claim 7 has been canceled.

Claims 1 and 12 – 16 have been withdrawn from consideration.

Claims 2 – 11 have been rejected.

Restriction

Previously a restriction requirement was made requiring election of the claims of either:

Group I: Claims 1 – 11, drawn to a method and a shunt; or

Group II: Claims 12 – 16, drawn to a catheter.

Claims 1 – 11 of Group I were elected with traverse.

Subsequently, the Examiner telephonically requested election between the claim 1 or claims 2 – 11. Applicant provisionally elected claims 2 – 11, with traverse.

While Applicant agrees that claim 1 and claims 2 – 11 are distinct and patentable over each other, it is respectfully submitted that the inventions should, nevertheless, be examined together. Both inventions are classified in the same class and should be searchable together.

Nevertheless, applicant confirms the election of claims 2 – 11, with traverse. Reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

Amendments to the Claims

Claim 2 has been amended.

In line 1, the article “a” has been added before “sinus shunting catheter” for clarification and to correct an obvious typographical error. No new matter has been added.

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Also in line 1, antecedent basis has been added for "cranium" by specifying that the patient has a cranium. Support for this amendment can be found throughout the specification. No new matter has been added.

The word "cranium" has been added between "said" and "proximate" in line 2 to correct a typographical error and clarifies where the one end of the catheter is inserted. Support for the amendment is replete throughout the specification. No new matter has been added.

In line 3, the word "into" has been replaced with the word "in." The phrase now reads "coupling a valve in said catheter." Support for this amendment can be found in specification, e.g., in paragraph [15], lines 4 – 5, on page 3, and paragraph [30], lines 4 – 7, on page 5, and the accompanying Figure 1. No new matter has been added.

In line 7, the phrase "said distal end" has been deleted. There is no antecedent basis for the term "distal end" and such term is not needed since the claim element already refers to "said opposite end" which has antecedent basis in line 4. No new matter has been added.

Claim 6 has been amended to add the subject matter of claim 7 to claim 6. No new matter has been added.

Claim 7 has been canceled since its subject matter has been added to claim 6.

Dependencies have been updated for claims 8 and 9.

No other claims have been amended.

Rejections Under 35 USC § 112

Claims 2, 4, 5, 7 and (presumably) 8 have been rejected under 35 USC § 112, second paragraph.

Claim 2 has been rejected under 35 USC § 112, second paragraph, for the phrase "into said proximate a ventricle" in line 2. As noted by the Examiner, due to a typographical error, the word "cranium" was omitted. Claim 2 has been amended to

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make this phrase read "into said cranium proximate a ventricle." This amendment should cure this rejection.

Claim 2 has also been rejected under 35 USC § 112, second paragraph, for the phrase "coupling a valve into said catheter" in line 3. Claim 2 has been amended to replace the word "into" with the word "in". It is clear from the description in paragraph [15] on page 3 and in paragraph [30] on page, especially in view of the drawing illustrated in Figure 1, that the phrase "coupling a valve in said catheter" means placing a valve somewhere in along the catheter, or at an end, as illustrated in the Figure. The valve is not simply coupled "to" the catheter since the valve may be placed somewhere in the middle of the catheter, exactly as illustrated in the Figure. This amendment to claim 2 should cure this rejection.

Claims 4, 5, 7 and (presumably) 8 have been rejected under 35 USC § 112, second paragraph, for the phrase "said catheter has approximately a one hundred eighty degree bend." This rejection is respectfully traversed. The Examiner states that the phrase is confusing "since 180 degrees is a straight line and therefore cannot be a bend." While 180 degrees might be construed to be a straight line, it is clear that a "one hundred eighty degree bend", where both "one hundred eighty degrees" and "bend" are required, describes the approximate U-shape illustrated in Figure 1. Figure 1 and the accompanying description in paragraph [36] on page 6, where the U-bend illustrated in Figure 1 is described as "approximately a one-hundred eighty degree bend" (paragraph 36, line 7), eliminates any possible confusion over the meaning of the phrase. Thus, it is respectfully submitted that the phrase is not vague nor indefinite and refers clearly to a configuration that is not a straight line. Thus, this rejection is in error and should be withdrawn.

Claim 4 has been rejected under 35 USC § 112, second paragraph, for lack of antecedent basis for the phrase "into said cranium" in line 4. However, claim 4 not does not have 4 lines and claim 4 does not contain the word "cranium." Perhaps, the Examiner was referring to claim 6 which does contain that phrase in line 4. However, claim 6 clearly has antecedent basis for "cranium" in line 3. Other claims under consideration

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also have support for "cranium," including claim 2 in which antecedent basis for "cranium" has been added in this amendment. At least with the amendments made in this Amendment, it is respectfully submitted that this rejection has either been cured or has been made in error. In either case, the rejection should be withdrawn.

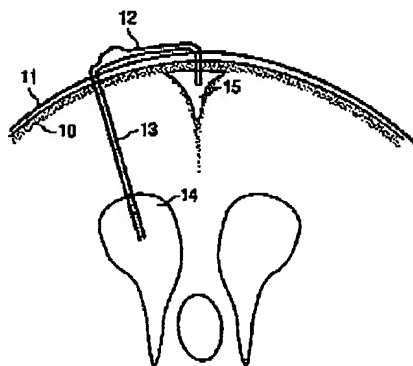
Rejections Under 35 USC § 102

Claims 2 – 11 have been rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,283,934, Børgesen ("Børgesen '934"). These rejections are respectfully traversed.

Børgesen '934 discloses a cerebrospinal fluid shunt system with a brain ventricular catheter for insertion into the brain ventricle so as to drain cerebrospinal fluid from the brain ventricle. A catheter is intended to be inserted into the sinus sagittalis for providing fluidic communication between the brain ventricle catheter and the sinus sagittalis catheter.

Børgesen '934 illustrates in Figure 8 the catheter inserted directly straight down into the sagittalis sinus (15).

FIG. 8



In this configuration, the catheter does NOT point generally in an upstream direction of blood flow within the sagittal sinus. Otherwise, Børgesen '934 is silent on the positioning the catheter in the sagittal sinus.

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In contrast, the present invention provides a cerebrospinal drainage catheter with a retrograde placement in the sagittal sinus as illustrated in Figure 1:

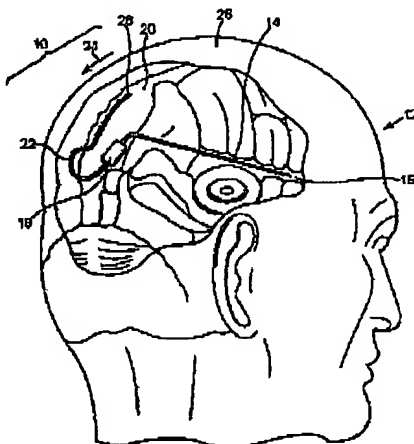


Fig. 1

Claim 2 requires "positioning said catheter so that said opposite end points generally in said upstream direction with respect to blood flow" in the superior sagittal sinus. As noted in the specification in paragraph [17], "positioning the discharge end of the sinus catheter in the retrograde facing the upstream flow of blood in the sagittal sinus helps the sinus catheter to prevent thrombosis. The collision of CSF flowing outward in an upstream direction in the sagittal sinus helps to prevent blood flowing in the sagittal sinus from forming a wake at the discharge point and possibly creating blood clotting conditions."

This structure is not shown, described nor suggested in Børgesen '934.

Independent claim 2 is patentable over Børgesen '934 and the rejection of claim 2 under 35 USC § 102 should be withdrawn.

Claims 3 – 5 are dependent upon claim 2 and since claim 2 is patentable over Børgesen '934, claims 3 – 5 should also be patentable over Børgesen '934. These rejections under 35 USC § 102 should also be withdrawn.

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Further, the catheter shown and described in Børgesen '934 does NOT contain "approximately a one hundred eighty degree bend" as required in claim 4. This is another reason why claim 4 is patentable over Børgesen '934.

Claim 6, as amended, requires a sagittal sinus shunt having a catheter with a sinus portion having "approximately a one hundred eighty degree bend." This structure is not shown, described nor suggested in Børgesen '934. Thus, claim 6 is patentable over Børgesen '934 and the rejection of claim 6 under 35 USC § 102 should be withdrawn.

Claims 8 – 11 are dependent upon claim 6 and since claim 6 is patentable over Børgesen '934, claims 8 – 11 should also be patentable over Børgesen '934. These rejections under 35 USC § 102 should also be withdrawn.


Summary

In view of the amendments made and the arguments presented, claims 1 – 6 and 8 – 11 should be allowable, this application should be in condition for allowance and a notice to that is earnestly solicited.

Respectfully Submitted,

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